

Amendment and Response

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Serial No.: 10/016,541

Confirmation No.: 7898

Filed: 11 December 2001

For: TACK-ON-PRESSURE FILMS FOR TEMPORARY SURFACE PROTECTION AND SURFACE
MODIFICATION

Remarks

The Office Action mailed February 19, 2004 has been received and reviewed. Claim 1 having been amended, the pending claims are claims 1-37. Claims 19-37 having been withdrawn from consideration by the Examiner as drawn to non-elected groups, claims 1-18 are currently under consideration.

Claim 1 has been amended to incorporate recitations from the preamble into the body of the claim.

Reconsideration and withdrawal of the rejections are respectfully requested.

Affirmation of Provisional Election

The Examiner issued a Restriction Requirement under 35 U.S.C. §121 in the above-identified application, grouping the claims as follows: Group I (claims 1-18), drawn to a method for temporary surface protection or surface modification; Group II (claims 19-33), drawn to a method for temporary surface protection or modification in a hospital or dental office; and Group III (claims 34-37) drawn to a bib. On August 6, 2003, Applicants' Representative, Doreen Gwin, made a provisional election with traverse to prosecute Group I (claims 1-18), in a telephone conversation with the Examiner. The provisional election to prosecute Group I is herein affirmed with traverse. Applicants respectfully request reconsideration and withdrawal or modification of the restriction requirement. It is respectfully submitted that the inventions as claimed can be readily evaluated in one search without placing undue burden on the Examiner.

Rejection under 35 U.S.C. §103

The Examiner rejected claims 1-16 and 18 under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,240,761 (Calhoun et al.) in view of the collective teachings of U.S. Pat. Nos. 4,556,595 (Ochi), 3,857,731 (Merrill et al.), 5,774,889 (Gochanour), and 6,493,879 (Hibler). Applicants respectfully traverse the rejection.

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"To establish a *prima facie* case of obviousness . . . there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." M.P.E.P. §706.02(j). Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness.

Calhoun et al., which is entitled "Electrically Conductive Adhesive Tape," states that "[t]he adhesive tape can be made by forming a dense monolayer of the particles, covering a stretchable adhesive layer with that dense monolayer, biaxially stretching the adhesive layer to separate each particle from other particles of the monolayer, and then embedding the particles either into that adhesive layer or into the adhesive layer of another tape" (abstract). Calhoun et al. further state that "[t]he method of the invention can be used to make products other than electrically conductive adhesive tape. For example, by substituting abrasive particles for electrically conductive particles in the above-outlined 3-step method, one can produce open-coat abrasive sheeting having equally spaced abrasive particles. This not only provides extraordinarily uniform abrasive action, but the spaces inhibit clogging." (Column 9, lines 3-10). However, Calhoun et al. fail to specifically disclose or suggest a method that provides temporary surface protection or surface modification (e.g., claim 1, as amended).

Ochi discloses "[a] pressure-sensitive adhesive sheet structure having relocatable properties composed of a pressure-sensitive adhesive layer and non-adhesive solid particles" (abstract). The solid particles "are randomly but uniformly distributed on at least one surface, or in at least one surface layer, of the pressure-sensitive adhesive layer. The 'uniform distribution', as used herein, does not mean that the particles are regularly and uniformly distributed, but it is sufficient that they are dispersed uniformly when observed macroscopically. A specially controlled state of distribution as in the prior art is not required, and for example, the solid particles may be applied to the surface of the pressure-sensitive adhesive layer by such a means as a powder applicator." (Column 7, lines 40-52).

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Merrill et al. disclose that "[a] pressure-sensitive sheet construction having particular utility as a durable, reusable bulletin board surface, comprises a substrate bonded to at least one surface thereof a binder material; partially embedded in the exposed surface of the binder and protruding therefrom are inherently tacky elastomeric copolymer microspheres (abstract). Merrill et al. further disclose that "[a]pplication of the binder-microsphere adhesive mixture to the substrate can be undertaken in any conventional manner. For example, the mixture may be coated to a desired thickness Alternatively, the mixture may be sprayed onto a substrate." (Column 5, lines 17-22).

However, Ochi and Merrill et al. each lack, among other things, a teaching or suggestion of a method to provide temporary surface protection or surface modification, the method including providing a sheet material having a base portion having physical characteristics of *having been non-elastically stretched in at least one dimension by a stretch ratio of at least 1:1.05*; and providing an activatable adhering side including a plurality of predetermined surface elements separated from each other leaving openings between adjacent surface elements, with *separation being caused by stretching of the sheet material* (e.g, claim 1 as amended).

Gochanour discloses "[a] protective hand covering for adhering to the user's hand. Pressure-sensitive adhesive is applied to the back surface of a sheet of thin flexible film, which is shaped to cover a protected area of the user's hand. The pressure-sensitive adhesive provides a sufficiently strong bond to prevent the hand covering from being inadvertently dislodged, but a sufficiently weak bond to allow the hand covering to be removed without injuring the user. The film is sufficiently impervious to contaminants to prevent the transfer of contaminants from the substance or object being handled to the user and vice versa" (abstract).

Hibler discloses "[a] self-adhering protective overlay employing a flexible sheet having a front surface, a back surface, and a periphery, with a pressure sensitive adhesive applied substantially to the periphery on the back surface." (abstract).

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However, Gochanour and Hibler each lack, among other things, a teaching or suggestion of a method including providing a sheet material having a base portion having physical characteristics of *having been non-elastically stretched in at least one dimension by a stretch ratio of at least 1:1.05*; and providing an activatable adhering side including a *plurality of predetermined surface elements separated from each other* leaving openings between adjacent surface elements (e.g., claim 1 as amended).

Thus, Applicants respectfully submit that one of skill in the art would have no motivation to modify Calhoun et al. by combining the teachings of Ochi and Merrill et al., both of which lack, among other things, a teaching or suggestion of a sheet material having a base portion having physical characteristics of *having been non-elastically stretched in at least one dimension by a stretch ratio of at least 1:1.05*. Further, Applicants respectfully submit that one of skill in the art would have no motivation to modify Calhoun et al. in view of Ochi and Merrill et al. by combining the teachings of Gocahlnour and Hibler, both of which lack, among other things, a teaching or suggestion of a *plurality of predetermined surface elements separated from each*. Moreover, Applicants respectfully submit that one of skill in the art would have no motivation to pick and choose among the disclosures of the five cited documents to arrive at Applicants' claimed invention, absent the impermissible use of hindsight reconstruction. Therefore, Applicants respectfully submit that claims 1-16 and 18 are patentable over Calhoun et al. in view of the collective teachings of Ochi, Merrill et al., Gochanour, and Hibler.

The Examiner rejected claims 15-17 under 35 U.S.C. §103(a) as being unpatentable over Calhoun et al. in view of the collective teachings of Ochi, Merrill et al., Gochanour, and Hibler as applied to claim 1, and further in view of U.S. Pat. No. 5,711,026 (Kaltman et al.). Applicants respectfully traverse the rejection.

Claims 15-17 depend from independent claim 1. Applicants respectfully submit that Kaltman et al. fail to provide the missing motivation in the rejection based on Calhoun et al.

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in view of the collective teachings of Ochi, Merrill et al., Gochanour, and Hibler, as discussed herein above.

Specifically, Kaltman et al. disclose sheets "capable of blocking solar ultraviolet radiation" (abstract). However, Kaltman et al. lack, among other things, a teaching or suggestion of a method including providing the sheet material having a base portion having physical characteristics of *having been non-elastically stretched in at least one dimension by a stretch ratio of at least 1:1.05*; and providing an activatable adhering side including *a plurality of predetermined surface elements separated from each other leaving openings between adjacent surface elements, separation being caused by stretching of the sheet material* (e.g., claim 1, as amended). Therefore, Applicants respectfully submit that claims 15-17 are patentable over Calhoun et al. in view of the collective teachings of Ochi, Merrill et al., Gochanour, and Hibler, and further in view of Kaltman et al. for at least the reasons recited herein above.

The Examiner rejected claims 1-4 and 6-14 under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,774,889 (Gochanour) in view of U.S. Pat. No. 5,240,761 (Calhoun et al.). The Examiner also rejected claims 1-3, 5-6, 8-10, 13-16, and 18 under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 6,493,879 (Hibler) in view of U.S. Patent No. 5,240,761 (Calhoun et al.). Applicants respectfully traverse the rejection.

The disclosures of Calhoun et al., Gochanour, and Hibler have all been discussed herein above. For reasons similar to those presented herein above, Applicants respectfully submit that the present combinations of documents still fails to provide the required motivation for one of skill in the art to combine or modify the teachings of the cited documents to arrive at the presently claimed invention. Therefore, Applicants respectfully submit that claim 1-4 and 6-14 are patentable over Gocahnour in view of Calhoun et al. and Hibler in view of Calhoun et al.

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The Examiner rejected claim 4 under 35 U.S.C. §103(a) as being unpatentable over Hibler in view of Calhoun et al. as applied to claim 1, and further in view of U.S. Pat. No. 6,256,788 (Loewer et al.). Applicants respectfully traverse the rejection.

Claim 4 depends from independent claim 1. Applicants respectfully submit that Loewer et al., fail to provide the missing motivation in the rejection based on Hibler in view of Calhoun et al., as discussed herein above.

Loewer et al. disclose "[a] disposable bib of absorbent sheet material" (abstract). However, Loewer et al. lack, among other things, a teaching or suggestion of a method including providing the sheet material having a base portion having physical characteristics of *having been non-elastically stretched in at least one dimension by a stretch ratio of at least 1:1.05*; and providing an activatable adhering side including *a plurality of predetermined surface elements separated from each other leaving openings between adjacent surface elements, separation being caused by stretching of the sheet material* (e.g., claim 1, as amended). Thus, Applicants respectfully submit that claim 4 is patentable over Hibler in view of Calhoun et al., and further in view of Loewer et al.

The Examiner rejected claims 7 and 11-12 under 35 U.S.C. §103(a) as being unpatentable over Hibler in view of Calhoun et al. as applied to claim 1, and further in view of U.S. Pat. No. 5,774,889 (Gochanour). Applicants respectfully traverse the rejection.

Claims 7 and 11-12 depend from independent claim 1. Applicants respectfully submit that Gochanour, the teachings of which have been discussed herein above, fails to provide the missing motivation in the rejection based on Hibler et al. in view of Calhoun et al., as discussed herein above. Therefore, Applicants respectfully submit that claims 7 and 11-12 are patentable over Hibler et al. in view of Calhoun et al., and further in view of Gochanour.

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The Examiner rejected claims 1-3, 6, 8-10, and 15-17 under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,711,026 (Kaltman et al.) in view of U.S. Patent No. 5,240,761 (Calhoun et al.). Applicants respectfully traverse the rejection.

The disclosures of Kaltman et al. and Calhoun et al. have both been discussed herein above. For reasons similar to those presented herein above, Applicants respectfully submit that the present combination of documents still fails to provide the required motivation for one of skill in the art to combine or modify the teachings of the cited documents to arrive at the presently claimed invention. Therefore, Applicants respectfully submit that claims 1-3, 6, 8-10, and 15-17 are patentable over Kaltman et al. in view of Calhoun et al.

The Examiner rejected claims 4, 7, and 11-12 under 35 U.S.C. §103(a) as being unpatentable over Kaltman et al. in view of Calhoun et al. as applied to claim 1, and further in view of U.S. Pat. No. 5,774,889 (Gochanour). Applicants respectfully traverse the rejection.

Claims 4, 7, and 11-12 depend from independent claim 1. Applicants respectfully submit that Gochanour, the teachings of which have been discussed herein above, fails to provide the missing motivation in the rejection based on Kaltman et al. in view of Calhoun et al., as discussed herein above. Therefore, Applicants respectfully submit that claim 4, 7, and 11-12 are patentable over Kaltman et al. in view of Calhoun et al., and further in view of Gochanour.

The Examiner rejected claim 18 under 35 U.S.C. §103(a) as being unpatentable over Kaltman et al. in view of Calhoun et al. as applied to claim 1, and further in view of U.S. Pat. No. 6,493,879 (Hibler). Applicants respectfully traverse the rejection.

Claim 18 depends from independent claim 1. Applicants respectfully submit that Hibler, the teachings of which have been discussed herein above, fails to provide the missing motivation in the rejection based on Kaltman et al. in view of Calhoun et al., as discussed herein

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above. Therefore, Applicants respectfully submit that claim 18 is patentable over Kaltman et al. in view of Calhoun et al., and further in view of Hibler.

In view of the remarks presented herein above, Applicants respectfully request that the Examiner reconsider and withdraw the rejections under 35 U.S.C. §103.

Double Patenting

The Examiner indicated that should claim 13 be found allowable, claim 14 will be objected to under 37 C.F.R. §1.75 as being a substantial duplicate thereof. The Examiner asserted that transparent and translucent are synonyms. Applicants respectfully disagree.

Applicants respectfully submit that one of skill in the art would recognize that transparent and translucent are not synonyms. *See, for example*, the separate definitions provided for "transparent" (Exhibit A) and "translucent" (Exhibit B) at www.dictionary.com.

Thus, Applicants respectfully submit that claim 14 is not a substantial duplicate of claim 13. Applicants respectfully request that the Examiner reconsider and withdraw the provisional double patenting rejection.

Provisional Obviousness-Type Double Patenting Rejection

Claims 1-16 and 18 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 6-16, 18-35, 37-50, and 52-58 of co-pending Application Serial No. 10/016,544 in view of the collective teachings of U.S. Pat. Nos. 4,556,595 (Ochi), 3,857,731 (Merrill et al.), 5,774,889 (Gochanour), and 6,493,879 (Hibler), and also in view of U.S. Pat. No. 5,240,761 (Calhoun et al.). Further, claim 17 was provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 6-16, 18-35, 37-50, and 52-58 of co-pending Application Serial No. 10/016,544 in view of the collective teachings of Ochi, Merrill et al., Gochanour, and Hibler, and also in view of Calhoun et al., and further in view of U.S. Pat.

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No. 5,711,026 (Kaltman et al.). Upon an indication of otherwise allowable subject matter and in the event this rejection is maintained, Applicants will provide an appropriate response.

Summary

It is respectfully submitted that all the pending claims are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to contact Applicants' Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted for
Sumita B. MITRA et al.

By
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June 21, 2004
Date

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Direct Dial (612)305-1225

CERTIFICATE UNDER 37 CFR §1.8:

The undersigned hereby certifies that the Transmittal Letter and the paper(s), as described hereinabove, are being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to Commissioner for Patents, Mail Stop Amendment, P.O. Box 1450, Alexandria, VA 22313-1450, on this 21st day of June, 2004, at 2:30 PM (Central Time).

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transparent


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trans·par·ent **Pronunciation Key** (trāns-pār'ənt, -pār'-)
adj.

1. Capable of transmitting light so that objects or images can be seen as if there were no intervening material. See Synonyms at [clear](#).
2. Permeable to electromagnetic radiation of specified frequencies, as to visible light or radio waves.
3. So fine in texture that it can be seen through; sheer. See Synonyms at [airy](#).
4.
 - a. Easily seen through or detected; obvious: *transparent lies*.
 - b. Free from guile; candid or open: *transparent sincerity*.
5. *Obsolete*. Shining through; luminous.

[Middle English, from Old French, from Medieval Latin *trānsparēns*, *trānsparēnt-* present participle of *trānsparēre*, to show through : Latin *trāns-*, *trans-* + Latin *pārēre*, to show.]

trans·par·ent·ly *adv.*

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Exhibit A

Dictionary.com/transparent

*Published by Houghton Mifflin Company. All rights reserved.*Main Entry: **trans·par·ent**

Pronunciation: - &nt

Function: *adjective***1** : having the property of transmitting light without appreciable scattering so that bodies lying beyond are seen clearly**2** : allowing the passage of a specified form of radiation (as X rays or ultraviolet light)Source: Merriam-Webster Medical Dictionary, © 2002 Merriam-Webster, Inc.**transparent**

\Trans*par"ent\, a. [F., from LL. *transparens*, -entis, p. pr. of *transparere* to be transparent; L. *trans* across, through + *parere* to appear. See *Appear*.] **1.** Having the property of transmitting rays of light, so that bodies can be distinctly seen through; pervious to light; diaphanous; pellucid; as, transparent glass; a transparent diamond; -- opposed to *opaque*. "Transparent elemental air." --Milton.

2. Admitting the passage of light; open; porous; as, a transparent veil. --Dryden.

Syn: Translucent; pellucid; clear; bright; limpid; lucid; diaphanous. See *Translucent*. -- *Trans*par"ent*ly*, adv. -- *Trans*par"ent*ness*, n.

Source: Webster's Revised Unabridged Dictionary, © 1996, 1998 MICRA, Inc.**transparent**

adj **1:** transmitting light; able to be seen through with clarity; "the cold crystalline water of melted snow"; "crystal clear skies"; "could see the sand on the bottom of the limpid pool"; "lucid air"; "a pellucid brook"; "transparent cristal" [syn: *crystalline*, *crystal clear*, *limpid*, *lucid*, *pellucid*] **2:** so thin as to transmit light; "a hat with a diaphanous veil"; "filmy wings of a moth"; "gauzy clouds of dandelion down"; "gossamer cobwebs"; "sheer silk stockings"; "transparent chiffon"; "vaporous silks" [syn: *diaphanous*, *filmy*, *gauzy*, *gossamer*, *see-through*, *sheer*, *vaporous*, *cobwebby*] **3:** free of deceit [syn: *guileless*] **4:** easily understood or seen through (because of a lack of subtlety); "a transparent explanation"; "a transparent lie"

Source: WordNet ® 1.6, © 1997 Princeton University**transparent**

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Exhibit A

1. <jargon> Not visible, hidden; said of a system which functions in a manner not evident to the user. For example, the Domain Name System transparently resolves a fully qualified domain name into an Internet address without the user being aware of it.

Compare this to what Donald Norman (<http://www.atg.apple.com/Norman/>) calls "invisibility", which he illustrates from the user's point of view:

"You use computers when you use many modern automobiles, microwave ovens, games, CD players and calculators. You don't notice the computer because you think of yourself as doing the task, not as using the computer." ["The Design of Everyday Things", New York, Doubleday, 1989, p. 185].

2. <theory> Fully defined, known, predictable; said of a sub-system in which matters generally subject to volition or stochastic state change have been chosen, measured, or determined by the environment. Thus for transparent systems, output is a known function of the inputs, and users can both predict the behaviour and depend upon it.

(1996-06-04)

Source: *The Free On-line Dictionary of Computing*, © 1993-2004
Denis Howe

Exhibit A

Perform a new search, or try your search for "transparent" at:

- Amazon.com - Shop for books, music and more
- Reference.com - Search the Web
- eLibrary - Search thousands of newspapers and magazines
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- Google Groups - Search Usenet messages back to 1981
- Merriam-Webster - Search for definitions
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Exhibit A



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trans-lu-cent **Pronunciation Key** (trăns-lō'sənt, trănz-)
adj.

1. Transmitting light but causing sufficient diffusion to prevent perception of distinct images.
2. Clear; lucid.

[Latin trānslūcēns, trānslūcent- present participle of trānslūcēre, to shine through : trāns-, trans- + lūcēre, to shine; see leuk- in Indo-European Roots.]

trans-lu'cence or trans-lu'cen-cy *n.*trans-lu'cent-ly *adv.*[\[Download or Buy Now\]](#)

Source: *The American Heritage® Dictionary of the English Language, Fourth Edition*

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Main Entry: trans-lu-cent

Pronunciation: -sənt

Function: *adjective*

: permitting the passage of light; *especially* : transmitting and diffusing light so that objects beyond cannot be seen clearly

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Exhibit B

Dictionary.com/translucent

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Source: *Merriam-Webster Medical Dictionary*, © 2002 Merriam-Webster, Inc.

translucent

\Trans*lu"cent\, a. [L. translucens, -entis, p. pr. of translucere to shine through; trans across, through = lucere to shine. See *Lucid*.] 1. Transmitting rays of light without permitting objects to be distinctly seen; partially transparent.

2. Transparent; clear. [Poetic] "Fountain or fresh current . . . translucent, pure." --Milton.

Replenished from the cool, translucent springs. --Pope.

Syn: Translucent, Transparent.

Usage: A thing is translucent when it merely admits the passage of light, without enabling us to distinguish the color and outline of objects through it; it is transparent when we can clearly discern objects placed on the other side of it. Glass, water, etc., are transparent; ground glass is translucent; a translucent style.

Source: *Webster's Revised Unabridged Dictionary*, © 1996, 1998 MICRA, Inc.

translucent

adj : almost transparent; allowing light to pass through diffusely; "translucent amber" [syn: semitransparent]

Source: *WordNet* @ 1.6, © 1997 Princeton University

translucent

translucent: in CancerWEB's On-line Medical Dictionary

Source: *On-line Medical Dictionary*, © 1997-98 Academic Medical Publishing & CancerWEB

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Exhibit B

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Exhibit B